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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/699,955	10/30/2000	Dennis P. Barry	1150/OH262	8257

7590  
Darby & Darby PC  
805 Third Avenue  
New York, NY 10022

10/08/2003

EXAMINER
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HUNTER, ALVIN A

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 10/08/2003

18

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/699,955

Applicant(s)

BARRY, DENNIS P.

Examiner

Alvin A. Hunter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 18 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,3,4 and 6-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,4 and 6-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 4 and 6-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barry (USPN 4093235) in view of Moore (USPN 3642286).

Barry discloses a tourist game for educating players with respect to tourist attractions within particular geographical regions (See Abstract). Barry discloses, word for word, all of the limitation claimed by the applicant except for having a parallelepiped or pyramid shaped multi-tokens means being the same or different colors with directional indicia on their ends. Moore discloses a game having changeable faces in which bear indicia on all sides (See Figures 2 and 3). The indicia possess different characteristics such as different power or capability, direction of movement, etc. (See Abstract and Entire Document). Moore also discloses that the playing pieces may be of different color to differentiate each player's pieces and are stackable (See Column 2, lines 24 through 30; and Column 4, lines 56 through 69). It would appear that stacking the pieces would prevent the pieces from crowding on a particular area of the board. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have indicia on a number of faces or ends of the game pieces, as taught

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by Moore, in order to show the different characteristics of the pieces such as capability and movement. The applicant does not disclose why it is critical for the multi-tokens to be an elongated parallelepiped or pyramid shaped, and therefore, it would be an obvious matter of design choice being that the game pieces of Moore, which are shown as being cubical, to make them of any similar shape such as parallelepiped (cubical) or pyramid shaped. It is inherent within Moore that one would grab the sides of the game piece in order to move the game piece. Though Barry or Moore does not disclose having gripping wings, the applicant does not disclose the criticality of the gripping wings, therefore, would have been an obvious matter of design choice. One having ordinary skill in the art would have expected the sides of Moore to functionally perform the same, which is to provide sides for moving the game piece.

### ***Response to Arguments***

Applicant's arguments filed June 18, 2003 have been fully considered but they are not persuasive. Applicant argues that the prima-facie obviousness has not been established because (a) the art relied upon by the examiner is not disclosed as having gripping wings and (b) the prior art relied upon does not have a parallelepiped shaped game pieces. The examiner respectfully disagrees. The applicant argues that the gripping wings are critical for one to grip the tokens and submitted articles relating to gripping objects with the fingertips in an effort to persuade the examiner. Unfortunately, the articles submitted by the applicant fail to show having knowledge of the matter before the filing of the application. The Washington Post article was published on July 4, 2003, almost three years after the filing of the application. The articles from M.I.T. have

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no date of publishing thereon. Furthermore, applicant specification gives not critically as to the functionality of gripping the token as was presently argued. The latent advantages of the gripping wings discovered by the applicant leads the examiner to believe that the arguments submitted by the applicant are spurious. If the gripping wing feature was of important, would the gripping wings also be placed on the pyramidal shaped token? The pyramidal shaped token is submitted to be suitable for gripping, based on the applicant's disclosure. The usage of the gripping wings, as described within the applicant's arguments, are not even disclosed within the specification. Does the specification disclose the recess of the gripping wing being used to receive a fingernail? Furthermore, does the claim require the recess to be used to receive a fingernail? From what was disclosed by the applicant, the gripping serves to be nothing more than an aesthetic feature. As indicated above, a cubical shape game piece possesses the same abilities as that of the applicant's multi-token and, therefore, it is believed that the above action was proper.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alvin A. Hunter whose telephone number is 703-306-5693. The examiner can normally be reached on Monday through Friday from 7:30AM to 4:00PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Sewell, can be reached on (703) 308-2126. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.



Paul T. Sewell  
Supervisory Patent Examiner  
Group 3700